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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/598,593	06/21/2000	John R Johnson	AVERP2580USA	7556

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William C Tritt
Renner Otto Boisselle & Sklar LLP
1621 Euclid Avenue
19th Floor
Cleveland, OH 44115

EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 02/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/598,593

Examiner

Victor S Chang

Applicant(s)

JOHNSON ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-6 and 8-25 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 and elsewhere, the position of pressure sensitive adhesive is not stated, nor indicated that it is a "layer"; also the "fade print" is not indicated as a "layer".

2. Claim 5 should depend on claim 4, not claim 1.
3. In claim 9, delete one of the two "over".
4. In claim 17, after "polymer layer", delete "and".
5. In claim 22, after "17", insert -- wherein the --.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Johnson et al. (US 5518786).

Johnson's patent is directed to a flexible decorative sheet for use in surfacing an automobile body panel (Abstract). FIG. 1 illustrates one embodiment of Johnson's invention, which includes, in combination, a flexible, foldable, heat-resistant, self-

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supporting first carrier sheet 10, and a transferable, adherent, flexible composite paint coat coated onto one surface of the first carrier sheet. The composite paint coat includes a clear coat 12 coated on the carrier sheet 10 and dried; a tie coat 14 coated on the dried clear coat; and a color coat 16 coated on the dried tie coat, in which the intervening tie coat provides a means of bonding the color coat and the clear coat. A layer of pressure-sensitive adhesive 18 is adhered to the side of the color coat (which inherently includes the fade print coat) opposite from the clear coat; and a second flexible, foldable, heat-resistant, self-supporting carrier sheet 20 supports the adhesive layer 18 (column 5, lines 20-37).

Claim lacks novelty.

Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-6, 10, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (US 5518786).

The teachings of Johnson are again relied upon as set forth above. Johnson discloses that the exterior surface of the composite paint coat has an exterior automotive quality gloss level and a distinctness-of-image value (applicant's claims 2) greater than about 60 (column 27, lines 65-67) and the second coat having sufficient

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elongation to enhance the elongation of the first coat so the composite paint coat has a level of elongation (claim 3) in the range from about 50% to about 150% the original dimension of the composite paint coat (column 28, lines 21-25). The clear coat (claims 4-6) preferably contains the fluorinated polymer and acrylic resin as its principal components. The fluorinated polymer component is preferably a thermoplastic fluorocarbon such as polyvinylidene fluoride (column 8, lines 27-30). The tie layer (claim 10) is based on acrylic resin (column 10, lines 28-29). The outer carrier sheets (claim 16) 10 and 20 provide exterior protection for the composite paint coat and its adhesive layer in a manner similar to a removable backing sheet (column 5, lines 40-43).

As such, if the reference is not considered to be an anticipation, in the absence of unexpected results it would have been obvious to one of ordinary skill in the art to make a multilayer decorative sheet based on the flexible decorative sheet as taught by Johnson, motivated by incorporating a well known variation of color coat (the fade print layer) and by the expectation of success imparted by the teachings of the prior art.

8. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (US 5518786) in view of Ellison et al. (US 4931324).

The teachings of Johnson are again relied upon as set forth above. Johnson fails to teach the use of polyvinyl chloride as clear coat layer (claim 8), or the multilayer sheet comprising a polyurethane cover coat (claim 9). Ellison's patent teaches the outer layer is formed from a substantially clear weatherable polymer, preferably a polymer selected from the group consisting of fluoropolymers, acrylate polymers,

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urethane polymers, vinyl polymers and blends thereof (column 2, lines 26-31). As such, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use polyvinylchloride for the clear coat layer and use the polyurethane as a cover coat, as taught by Ellison, to modify Johnson's multilayer decorative sheet, motivated by the improved weatherability of these polymers as clear coat on the multilayer decorative sheet, and by the expectation of success imparted by the teachings of the prior art.

9. Claims 11-15 and 17-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (US 5518786) in view of Carroll, Jr. (US 5192609).

The teachings of Johnson are again relied upon as set forth above. Johnson fails to teach a multilayer decorative sheet comprising a backing layer between the color (or fade print) layer and the pressure sensitive adhesive. Carroll's patent relates to flexible decorative sheet materials that are capable of being stretched and bonded to a three-dimensional substrate (column 1, lines 12-16). FIG. 2 is a diagrammatic cross-sectional side view. Layer 11 is a flexible and stretchable, thermoplastic polymeric carrier film between the basecoat (color layer) and pressure sensitive adhesive layer (column 3, lines 49-61). The Examiner takes Official Notice that the 'carrier layer' in Carroll's invention is structurally and functionally equivalent to the 'backing layer' in the instant claimed invention. Such a carrier film can be colored by melt-blending a dark pigment or dye with the carrier film polymer composition before extruding the film (column 6, lines 38-40). The carrier film has heat softening and tensile elongation properties suitable for the thermoforming process. Preferred polymeric materials for the

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film are polyvinyl chloride, polyvinyl acetate, etc. (column 4, lines 41-45). As such, in the absence of unexpected results it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a polyvinylchloride carrier film (backing layer), as taught by Carroll, into Johnson's multilayer decorative sheet, motivated by the improved elongation properties of the multilayer sheet, and by the expectation of success imparted by the teachings of the prior art.

With respect to claims 11, the Examiner takes Official Notice that reducing the color density is an inherent product specification of fade print, and would have been obvious to one having ordinary skill in the art at the time the invention was made to specify an appropriate amount of color density reduction of a fade print.

With respect to claims 21 and 22, the Examiner takes Official Notice that it is common knowledge to include appropriate amount of plasticizer, UV absorber and heat stabilizer in the formulation of an optically clear chlorinated polymer. In the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate these additives in the chlorinated polymer to improve its optical clarity, UV and heat stabilities, motivated by the improved physical properties of the multilayer sheet, and by the expectation of success imparted by the teachings of the prior art.

10. Claim 7 is not rejected on the basis of prior art.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In addition, the following references are cited of interested for multilayer decorative sheet:

US 5034269 to Wheeler

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0771 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC

VSC
January 25, 2002

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1900

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Daniel Zinker